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WASHINGTON DC 20036

**MAILED**

FEB 24 2012

In re Patent of	:	
Elberto Berdut	:	<b>OFFICE OF PETITIONS</b>
Patent No.: 5,586,505	:	
Issue Date: 12/24/1996	:	
Application No. 08/392247	:	
Filing or 371(c) Date: 02/22/1995	:	<b>ON PETITION</b>
Title of Invention:	:	
LEVITATION SYSTEM USING	:	
PERMANENT MAGNETS FOR USE : WITH	:	
TRAINS AND THE LIKE TYPE OF RIGHT-	:	
OF-WAY VEHICLES	:	

This is a decision on the petition under 37 CFR § 1.378(e), filed January 10, 2012, requesting reconsideration of a decision dismissing a petition to reinstate the above-identified patent.

The petition is **DENIED**.

This decision is a final agency action within the meaning of 5 U.S.C. §704 for purposes of seeking judicial review.

**Background**

The patent issued December 24, 1996. Patentee could have paid the eleven and one half (11½) year maintenance fee between December 24, 2007, and June 24, 2008, without a surcharge, or within the six (6) month grace period between June 25, 2008 and December 24, 2008. Patentee failed to do so; accordingly, the patent became expired on December 25, 2008.

**The September 2, 2011 petition**

Patentee filed a petition on September 2, 2011, to reinstate the above identified patent, wherein petitioner provided that in celebrating his latest allowance, the patent owner requested current

counsel to check on his other patents, including the present patent, and discovered that the present patent had expired for non-payment of the maintenance fee. Petitioner provided further that the patent owner was born in Cuba and raised his family in Puerto Rico, and speaks no English. Petitioner stated

[w]hile we know that under California Med. V. Technol Med. (D. Del 1995) a patent owner has to make some effort to educate his/herself, Don Elberto speaks no English, and thus would have been hard pressed to have a casual conversation with his previous representatives. As with another of my "Boricua" clients (although Don Elberto was born in Cuba, he raised his family in PR), he would be hard pressed to find information and incapable of reading most if not all USPTO documents.

#### The November 3, 2011 Decision on petition

A Decision dismissing the petition was mailed on November 3, 2011. The Decision informed petitioner that a patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminders does not constitute unavoidable delay. The law requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Here, Patentee was unaware of the need to pay the maintenance fee and had not demonstrated that any steps were taken to ensure timely payment of the maintenance fee. The lack of knowledge of the requirement to pay a maintenance fee will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

#### The present request for reconsideration of petition

Petitioner files the present request for reconsideration of petition and clarifies his previous explanation regarding petitioner's failure to pay the maintenance fee. Petitioner explains that on previous occasions payment of the maintenance fee was done through Marks & Murase, LLP, who would notify petitioner of the need to pay, and send petitioner a bill. In this manner the fees for the patent (for the 4 and 8 year windows), were paid. Petitioner provides further that as recently as April 2005 the fees were paid in this manner.

During 2008 (for payment of the present maintenance fee), petitioner received no notification requesting the payment. However, since the system that worked for all other cases failed this time, the present petition is filed. Petitioner concludes that the inventor's interests are being harmed by the premature expiration of the present patent, particularly when the 4 and 8 year maintenance fees were already paid, thereby demonstrating the inventor's intent to assert his IP rights.

#### Applicable Law, Rules and MPEP

##### Petition to reinstate under 37 CFR 1.378(b)

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The applicable law requires a showing that the delay in paying the maintenance fee was unavoidable despite reasonable care being taken to ensure that the maintenance fee would be timely paid. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. See, Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988), aff’d sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff’d, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

Because 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee’s lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, supra. See also Final Rule entitled “Final Rules for Patent Maintenance Fees,” published in the *Federal Register* at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the *Official Gazette* at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are

due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Finally, petitioner is advised that a breakdown of communication between petitioner and his representative is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard. See, Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

### **Opinion**

Patentee files the instant petition and clarifies that the reason for the delay in payment of the maintenance fee was because petitioner received no notification from Marks & Murase, LLP requesting the payment. However, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay.

Moreover, a breakdown of communication between petitioner and his representative is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard.

### **Decision**

The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of June 15, 2009 has been reconsidered; however, the renewed petition to accept under 37 CFR 1.378(e) the delayed payment of a maintenance fee and reinstate the above-identified patent is **DENIED**.

This patent file is being forwarded to the Files Repository.

Telephone inquiries concerning this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is written over the printed name.

Anthony Knight  
Director  
Office of Petitions

CC: LUIS FIGARELLA  
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